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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/644,976	08/21/2003	Shouhei Kozakai	0171-1012P	6358

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EXAMINER	
ROBERTSON, JEFFREY	
ART UNIT	**PAPER NUMBER**
1712	

DATE MAILED: 03/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/644,976	KOZAKAI ET AL.	
	Examiner	Art Unit	
	Jeffrey B. Robertson	1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 January 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1 and 4-15* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1 and 4-15* is/are rejected.

7)☒ Claim(s) *1,4,5 and 10* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1. Claims 1, 4, 5, and 10 are objected to because of the following informalities: for claim 1, after "(C)", applicant has amended the claim to read "a crosslinking comprising". There appears to be some words missing. For claim 10, the claim fails to further limit claim 9 because the limitations for component (B) are the same as set forth in claim 9. Appropriate correction is required.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 4-10, 12, and 13 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of copending Application No. 10/676,146. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 of the instant application encompasses the composition in clam 1 of application 10/676,146. Specifically, both claim 1 of the instant application and claim 1 of the '146 application

set forth a partially condensed mixture of a diorganopolysiloxane containing hydroxyl groups of formula (1) and an organopolysiloxane copolymer. The language of claim 1 of the instant application allows for the presence of alkenyl groups in the copolymer and a platinum based catalyst. In addition, the silane component (B) encompasses the silane of general formula (2) set forth in the '146 application. Claims 4 and 5 of each application are identical. Claims 6-10, 12, and 13 are similar to claims 1, 3, 4, and 5 of the '146 application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 9-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aoki (US 2002/0013386 A1) in view of Ushizaka et al. (U.S. Patent No. 5,415,912).

For claims 9 and 11, Aoki teaches a silicone composition that contains 100 parts by weight of a condensation product of a diorganopolysiloxane that is hydroxyl terminated and contains not less than 500 repeat units with an organopolysiloxane that contains MQ units in a ration of 0.6 to 1.3, which is within applicants range. Paragraphs [0011]-[0015]. The composition also contains a peroxide-curing agent. Paragraph [0016]. Aoki also teaches that the organopolysiloxane contains hydroxyl groups in paragraph [0022].

For claims 12-15, Aoki teaches the formation of films containing the composition of the patent, where the composition is cured. See paragraphs [0028], [0029], and [0047].

Aoki fails to teach the addition of a silane compound corresponding to applicant's component (B).

Ushizaka teaches silicone pressure sensitive adhesive compositions containing silicon-bonded hydroxyl groups. Col. 3, lines 8-13. Ushizaka teaches the addition of

silanes specifically mentioning methacryloxypropyltrimethoxysilane in col. 5, lines 30-48. Although the amount of the silane added is not set forth in the patent, this amount is a result effective variable and would be determined according to the crosslinking properties required in the resulting composition.

Fujita and Ushizaka are analogous art in that they both come from the same field of endeavor, namely pressure sensitive adhesives containing silicon-bonded hydroxyl groups. It would have been obvious to one of ordinary skill in the art at the time of the invention to add the silanes of Ushizaka to the compositions to Aoki. The motivation would have been that Ushizaka teaches advantages for the addition of the silanes for crosslinking. One of ordinary skill in the art would have added the silane to impart these advantages to the compositions of Aoki.

Response to Arguments

7. Applicant's arguments filed 1/12/06 have been fully considered but they are not persuasive.

Regarding the double patenting rejection, applicant argues that the claims of Application No. 10/676,146 are patentably distinct from the instant claims because the present claims do not contain the compound of general formula (2) set forth in the '146 application. Applicant also argues that the '146 application sets forth a different manner of obtaining adhesion due to the introduction of alkoxysilyl groups into the organopolysiloxane copolymer (ii). The examiner disagrees with these arguments. First, the compound of general formula (2) set forth in the '146 application corresponds to applicant's component (B). Component (B) requires a silicon bonded alkoxy group

and an organic group that may be a silicon-bonded hydrogen group. General formula (2) contains both of these required structural characteristics. Therefore, these two ingredients are the same. Regarding the presence of alkenyl groups in component (ii), applicant's arguments are not persuasive because R^3 of (A)(ii) in the present application may be an alkenyl radical. Thus, the present claims encompass situations where the way of improving adhesiveness are the same as disclosed in the '146 application.

Regarding applicant's arguments pertaining to new claims 9-15, these arguments are moot in view of new grounds of rejection. It is noted that applicant argues that Aoki does not disclose or suggest a composition that can be formed into a release sheet peeled from the film form and press bonded to the substrate with permanent adhesion and that Aoki fails to teach that the composition can be formed into a film adhesive by itself. In response, the examiner notes that applicant is not claiming a release sheet peeled from the film form and press bonded to the substrate. As set forth above, Aoki discloses films that contain the adhesive as claimed. The claim language encompasses situations that include backings.

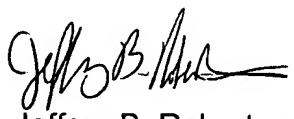
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey B. Robertson whose telephone number is (571) 272-1092. The examiner can normally be reached on Mon-Fri 7:00-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy P. Gulakowski can be reached on (571) 272-1302. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jeffrey B. Robertson
Primary Examiner
Art Unit 1712

JBR